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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,627	12/12/2001	Heiner Max	100718- 357/Beiersdorf 75	9248
27384	7590	04/19/2005	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS, PA 875 THIRD STREET 18TH FLOOR NEW YORK, NY 10022			KIM, VICKIE Y	
			ART UNIT	PAPER NUMBER
			1618	

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/021,627

Applicant(s)

MAX ET AL.

Examiner

Vickie Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-32 is/are pending in the application.
- 4a) Of the above claim(s) 14-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Status of Application***

1. Acknowledgement is made of amendment filed Feb 06, 2004. Upon entering the amendment, the claims 19-31 are amended and the claim 32 is newly added.

The claims 19-32 are pending and presented for the examination. Claims 1-13 are previously canceled and Claims 14-18 are previously withdrawn as non-elected invention.

### ***Claim Objections***

2. Claim 27 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitation recited in claim 27(i.e. EDTA) is not included in the scope of claim 26. The scope of the dependent claim 27 should be narrower than the previous claim 26 whereas claim 26 is limited to a citric acid, tartaric acid or aminopolycarboxylic acid as chelating agents.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 19-31 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 19-25 and 27-32 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kung et al(US2002/0123460A1).

The claims are drawn to a cosmetic oil-in-water or water-in-oil preparation for topical application to the skin comprising (a) an oil phase; (b) an aqueous phase; (c) folic acid (d) a complexing agent. The claims 20-23 require the concentration of folic acid present in the preparation (@ 0.01-10%) and the claims 25-30 require complexing agent(=chelating agent, e.g. EDTA @ 0.01-10%).

Kung et al(US'460, hereinafter) teach a composition comprising an oxygen-labile species(e.g. folic acid , see claim 6). US'460 further teaches that the patented composition also comprises EDTA as a chelating agent, see examples. Especially US'460 teaches folic acid is a water soluble oxygen labile species that is present in the composition in amounts of from about 0.01to about 20% and functionally active ingredient and equivalent to other water soluble oxygen labile species such as ascorbic acid, lipoic acid, etc, see paragraph 15 at page 1. US'460 teaches a standard oil-in-

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acid, lipoic acid, etc, see paragraph 15 at page 1. US'460 teaches a standard oil-in-water emulsion(paragraph 24 at page 2) and also exemplifies a composition containing ascorbic acid(water soluble oxygen labile species), EDTA(chelator, about 0.1%), see examples 9-15. Since US' 460 teaches all the critical elements required by the instant claims, all the claims are properly included in this rejection.

Although US'460 does not show a example having both folic acid and chelator(e.g. EDTA), substitution of ascorbic acid with folic acid would have been readily apparent to any skilled artisan because they are functionally equivalent water soluble oxygen labile species as taught through the patent disclosure and thus, obvious absent evidence to the contrary.

Thus, all the claims are properly included in this rejection and the claimed invention is not considered to be patentably over the prior art of the record.

### ***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kung et al(US 460) in view of Deckner et al(US4847267).

Kung et al's teaching is mentioned immediately above in 102/103 rejection.

The claim 25 is different from Kung et al(US'460) because it requires citric acid, tartarin acid or aminopolycarboxylic acid as a chelating agent.

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US'460 is taken in view of Deckner(US'267) because US'267 teaches citric acid is a effective chelating agent used in cosmetic composition(topical application) and functionally equivalent to EDTA, see claim 5.

One would have been motivated to make such substitution, with reasonable expectation of success because it is always desirable to have extended the option for substitution on ingredients to improve patient's compliance by enhancing patient satisfaction and increasing the selection option. The techniques and skills required for making such substitution is conventional knowledge or well within the skills of ordinary artisan.

### ***Conclusion***

8. No claim is allowed.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickie Kim whose telephone number is 571-272-0579.

The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Low be reached on 571-272-0953. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**VICKIE KIM**  
**PRIMARY EXAMINER**

Vickie Kim  
Primary Patent Examiner  
April 14, 2005  
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